REMARKS

In the final Office Action mailed September 15, 2009:

(i) claims 1-30 and 47 were rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter;

(ii) claims 1-10, 13-20, 31-33 and 43-46 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Lawlis, et al., "A Formal Process for evaluating COTS Software Products", (C) 2001 IEEE, Computer, pp. 58-63 (hereinafter "Lawlis") in view of Mamoukaris et al, "Evaluation of web-based educational systems", 2000, vol. 1, Academy of Business Education, pp. 1-6 (hereinafter "Mamoukaris") and in further view of Brown, "Using computers to deliver training: Which employees learn and why?", Personnel Psychology 2001;

(iii) claims 11, 12, 21-30 and 34-42 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Lawlis in view of Mamoukaris and Brown and in further view of Cheryl Murphy, An Evaluation Format For "Open" Software Tools, Computers and Human Behavior, vol. 11, no. 3-4 , pages 619-631, 1995, (hereinafter "Murphy") and Matthew Owen Howard, R. Dale Walker, Patricia Silk Walker, & Richard T. Suchinsky, Alcohol and Drug Education in Schools of Nursing, Journal of Alcohol and Drug Education, vol. 42, issue 3, Spring 1997, at 54, (hereinafter Howard); and

(iv) claim 47 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Lawlis in view of Mamoukaris and Brown and in further view of Richard B. Freeman; "Occupational Training In Proprietary Schools and Technical Institutes"; The Review of Economics and Statistics, Vol. 56, No. 3 (Aug. 1974), pp. 310-318 (hereinafter "Freeman").

Applicants respectfully traverse and request reconsideration.

Rejection Of Claims 1-30 and 47 Under § 101

Claims 1-30 and 47 stand rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. In light of this rejection, claims 1, 5 and 21 have been amended above to more clearly tie the claimed process to the recited computer. As such, Applicants respectfully submit that claims 1-30 and 47 recite patentable subject matter and are now in suitable condition for allowance.

Rejection Of Claims 1-10, 13-20, 31-33 Under § 103(a) Given Lawlis in view of Mamoukaris and Brown

Claims 1-10, 13-20, 31-33 and 43-46 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Lawlis in view of Mamoukaris and Brown. In their Preliminary Amendment and Response dated June 8, 2009 ("the June '09 response"), Applicants presented arguments in response to the rejection of claims 1-10, 13-20, 31-33 and 43-46:

(i) that the Lawlis in view of Mamoukaris fails to teach the claimed limitation of "educational product alignment values [representing] the alignment of each educational product to said business organization's goals with respect to employee training";

(ii) that the Office incorrectly asserted that the claimed limitation of "business goal rule data representing a business organization's goals with respect to employee training", based on the instructions and case law examples noted in M.P.E.P. § 2106, constitutes "descriptive material [that] will not distinguish the prior art in terms of patentability"; and

(iii) that Lawlis in view of Mamoukaris fails to teach the claimed limitation of "business goal rule data representing a business organization's goals with respect to employee training."

In the instant Office Action, at page 3, the Office mischaracterizes the first and second arguments noted above:

> The applicants argue that the [references] fail to teach "educational product alignment values, for indicating the alignment of each

> educational product to said business organization's goals with respect to employee training". In further support of this argument, the applicant traverses the examiner's notion that the data is nonfunctional descriptive material.

Following up on this new basis for rejecting the claims, the Office further states:

> The examiner notes that the cited limitation includes a "for" after "values". This indicates that the values are being used "for" something. They are being used to indicate alignment with respect to goals. This is an intended use limitation. The applicant is comparing scores against a goal to determine if the goal is met. The cited references teach comparison criteria. This is the same functionality as is provided by the claims, that of using values generated to determine how those values compare, i.e. with goals.

Applicants first note that their actual argument concerning the citation of M.P.E.P. § 2106 and the case law cited therein was to refute the apparent assertion by the Office that the claimed limitation of "business goal rule data representing a business organization's goals with respect to employee training" constituted impermissible printed matter. Thus, the Office's response in the instant Office Action to these arguments noted above wholly fails to address the substance of Applicants' actual argument. (See M.P.E.P. § 707.07(f): "Where the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it.")

Instead, the Office has provided a new basis for asserting that a different limitation, i.e., the "educational product alignment values, for indicating the alignment of each educational product to said business organization's goals with respect to employee training" limitation, constitutes nonfunctional descriptive material. Without citation to any legal authority, the Office states that the formulation of "values, for indicating . . ." is interpreted to mean "that the values are being used 'for' something" and that this is therefore an "intended use limitation." (instant Office Action, page 3) Again, no legal authority for this interpretation of the limitation is

provided. Indeed, by this rationale, all "means for" type limitations, even though permitted by statute under 35 U.S.C. § 112, sixth paragraph, would constitute intended use limitations.[1]

The Office further states (instant Office Action, page 3) that:

> The applicant is comparing scores against a goal to determine if the goal is met. The cited references teach comparison criteria. This is the same functionality as is provided by the claims, that of using values generated to determine how those values compare, i.e. with goals.

Once again, Applicants are unaware of any legal authority for the proposition that prima facie obviousness is demonstrated where the cited references allegedly show "the same functionality as . . . provided by the claims." Rather, obviousness can only be predicated on a showing that all limitations of the claims have been considered. (See, M.P.E.P. § 2143.03: "All words in a claim must be considered in judging the patentability of that claim against the prior art." (citation omitted)) That is, the "functionality" of a claim cannot replace the limitations set forth by the actual language of the claim. See, e.g., *Warner-Jenkinson Co., Inc. v. Hilton Davis Chemical Co.*, 520 U.S. 17, 41 (1997) ("Each element contained in a patent claim is deemed material to defining the scope of the patented invention . . . .") Applicants respectfully submit that it is improper for the Office to rely on this rationale.

Applicants have further noted the rationale provided on page 4 of the instant Office Action that labeling something that is representative of "a business organization's goals with respect to employee training" as "business goal rule data" is insufficient to distinguish the claims over the cited art to the extent that the claimed invention and the prior art allegedly "work exactly the same way." In other words, as further noted by the Office, "the labels of the

[1] Despite this, Applicants note that claims 5, 34 and 39 have been amended above to eliminate this phrasing, thereby more forcefully demonstrating the functional nature of the claimed "education product alignment values."

thresholds, i.e., 'business goal rules', does not distinguish the rules over the prior art because the functionality is the same." Once again, the Office appears to be relying on an alleged showing of equivalence of "functionality" as a proxy (or worse, substitute) for the actual claim language. As noted above, however, it is not proper for the Office to simply ignore the express language of the claims; the alleged "labels" recited in the claim have to be accorded some meaning. Indeed, the simple characterizations of limitations in a claim as nonfunctional descriptive material or intended use limitations in order to ignore them in favor of a "functionality" basis for rejecting claims is improper.[2]

With that basis, Applicants respectfully re-submit their arguments set forth the June '09 response, i.e., that the references fail to teach the claimed limitation of "educational product alignment values [representing] the alignment of each educational product to said business organization's goals with respect to employee training", and that the references fail to teach the claimed limitation of "business goal rule data representing a business organization's goals with respect to employee training."

Applicants have noted the further application of Brown to the combination of Lawlis in view of Mamoukaris. With regard to claim 5, noting that Lawlis in view of Mamoukaris fails to teach "where the business goal rule data corresponds to a business organization's goals with respect to employee training," the Office further alleges, citing page 282 of Brown, that "Brown suggests using a standard scoring approach . . . to evaluate employee learning (i.e., business goal rule data corresponds to a business organization's goals.)" In this instance, it appears that paraphrasing of the actual claim language has lead to the erroneous conclusion that Brown teaches the claimed limitation. Specifically, the cited portion of Brown concerns a scoring

[2] This is particularly true where, as noted above, arguments have been provided refuting the

technique for assessing how well students had learned and were able to apply the course material. That is, the "standard scoring approach" taught by Brown is relevant to a *student's performance* in view of training, but is otherwise not related to anything "representing a *business organization's goals* with respect to employee training," as presently claimed. That the alleged scoring technique taught by the combination of Lawlis in view of Mamoukaris is a standard one or that Brown teaches a standard scoring approach for assessing student performance simply does not rise to a demonstration that any of the references, either alone or in combination, contemplates the use of "business goal rule data representing a business organization's goals with respect to employee training" when those words are given their ordinary meaning commensurate with the instant specification. See, M.P.E.P. § 2111.01. For this reason, Applicants respectfully submit that the combination of Lawlis in view of Mamoukaris and in further view of Brown fail to establish prima facie obviousness of claim 5 and respectfully request withdrawal of the rejection of claim 5. Furthermore, independent claims 1, 31 and 43 also include this limitation, rendering these claims patentable for at least the same reasons as claim 5 set forth above. Further still, dependent claims 2-4, 6-10, 13-20, 32, 33 and 44-46 incorporate the limitations of respective ones of independent claims 1, 5, 31 and 43, thereby rendering these dependent claims allowable for at least the same reasons.

Rejection Of Claims 11, 12, 21-30 and 34-42 Under § 103(a) Given Lawlis in view of Mamoukaris and Brown and in further view of Murphy and Howard

Claims 11, 12, 21-30 and 34-42 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Lawlis in view of Mamoukaris and Brown and in further view of Murphy and Howard. As an initial matter, Applicants note that the further application of Murphy and Howard to the combination of Lawlis, Mamoukaris and Brown fails to over the shortcomings of

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alleged shortcomings of the limitations, but not answered by the Office.

Lawlis in view of Mamoukaris and Brown noted above, i.e., their failure to teach "business goal rule data representing a business organization's goals with respect to employee training". Applicants further note that independent claim 21, 34 and 39 include the "business goal rule data representing a business organization's goals with respect to employee training" limitation and are therefore in suitable condition for allowance for at least the same reasons presented above with regard to claim 5. Further still, dependent claims 11, 12, 22-30, 34-38 and 40-42 incorporate the limitations of respective ones of independent claims 5, 21, 34 and 39, thereby rendering these dependent claims allowable for at least the same reasons presented above.

Rejection Of Claim 47 Under § 103(a) Given Lawlis in view of Mamoukaris and Brown and in further view of Freeman

Finally, claim 47 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Lawlis in view of Mamoukaris and Brown and in further view of Freeman. Once again, Applicants note that the further application of Freeman to the combination of Lawlis, Mamoukaris and Brown fails to over the shortcomings of Lawlis in view of Mamoukaris and Brown noted above, i.e., their failure to teach "business goal rule data representing a business organization's goals with respect to employee training". Thus, to the extent that claim 47 is dependent upon, and therefore incorporates the limitations of claim 5, Applicants respectfully submit that claim 47 is in suitable condition for allowance for at least the same reasons presented above with regard to claim 5.

Conclusion

It is believed that all of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully requests reconsideration and withdrawal all presently outstanding rejections. Thus, prompt and favorable consideration of this response is respectfully requested. If it is believed that personal communication will expedite prosecution of this application, Applicant's undersigned representative may be contacted at the number below.

Respectfully submitted,

/Christopher P. Moreno/

Date: March 15, 2010 By:_____

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